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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/674,588

09/30/2003

Ruven E. Brooks

110003.00048.03SW195

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7590

05/05/2004

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EXAMINER

LE, JOHN H


ART UNIT

PAPER NUMBER

2863

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--|--|
| Office Action Summary | Application No. 10/674,588 | Applicant(s) BROOKS ET AL.  | |
| | Examiner John H Le | Art Unit 2863 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-34, 70-74, drawn to a method for identifying at least a section of a first schematic associated with at least a section of a second schematic.
- II. Claims 35-42, drawn to a method for generating electrical schematics including electrical icons indicating electrical components useable to control mechanical components that are indicated by mechanical icons on pre-existing mechanical schematics.
- III. Claims 45-54 drawn to a method for identifying mechanical components on the mechanical schematics that are not supported by the control system defined by the electrical schematics.
- IV. Claims 55-69, drawn to a method for use with pre-existing electronically stored electrical and mechanical schematics where the electrical schematic indicates a control system to be used to control mechanical components corresponding to the mechanical schematic.
- V. Claims 75-79, drawn to a method for identifying sections of an existing schematic that are consistent with best design practices.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as invention of group I does not required steps identifying electrical components suitable for controlling the identified at least one sub-set of mechanical components; and using the identified electrical components to generate an electrical schematic for controlling the identified at least sub-set of mechanical components on the mechanical schematic of group II and invention of group II does not required steps examining the second schematic to identify at least one instance of components of the second type that are associated with the identified components of the first type; and when at least one instance of components of the second type is identified, rendering the at least one instance accessible of group I. See MPEP § 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as invention of group I does not required steps identifying at least a sub-set of mechanical components in the mechanical schematics that are not supported by the electrical components in the electrical schematics of group III and invention of group III does not required steps examining the second schematic to identify at least one instance of components

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of the second type that are associated with the identified components of the first type; and when at least one instance of components of the second type is identified, rendering the at least one instance accessible of group I. See MPEP § 806.05(d).

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as invention of group I does not required steps monitoring for changes to the mechanical schematic; for each change to the mechanical schematic, storing an indication of the change in a database of group IV and invention of group IV does not required steps examining the second schematic to identify at least one instance of components of the second type that are associated with the identified components of the first type; and when at least one instance of components of the second type is identified, rendering the at least one instance accessible of group I. See MPEP § 806.05(d).

Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as invention of group I does not required steps examining the existing schematic to identify sections of the existing schematic that are inconsistent with the best design practices specified in the template set of group V and invention of group V does not required steps examining the second schematic to identify at least one instance of components of the second

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type that are associated with the identified components of the first type; and when at least one instance of components of the second type is identified, rendering the at least one instance accessible of group I. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as invention of group II does not required steps identifying at least a sub-set of mechanical components in the mechanical schematics that are not supported by the electrical components in the electrical schematics of group III and invention of group III does not required steps identifying electrical components suitable for controlling the identified at least one sub-set of mechanical components; and using the identified electrical components to generate an electrical schematic for controlling the identified at least sub-set of mechanical components on the mechanical schematic of group II. See MPEP § 806.05(d).

Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as invention of group II does not required steps monitoring for changes to the mechanical schematic; for each change to the mechanical schematic, storing an indication of the change in a database of group IV and invention of group IV does not required steps identifying electrical

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components suitable for controlling the identified at least one sub-set of mechanical components; and using the identified electrical components to generate an electrical schematic for controlling the identified at least sub-set of mechanical components on the mechanical schematic of group II. See MPEP § 806.05(d).

3. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as invention of group II does not required steps examining the existing schematic to identify sections of the existing schematic that are inconsistent with the best design practices specified in the template set of group V and invention of group V does not required steps identifying electrical components suitable for controlling the identified at least one sub-set of mechanical components; and using the identified electrical components to generate an electrical schematic for controlling the identified at least sub-set of mechanical components on the mechanical schematic of group II. See MPEP § 806.05(d).

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as invention of group III does not required steps monitoring for changes to the mechanical schematic; for each change to the mechanical schematic, storing an indication of the change in a database of group

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IV and invention of group IV does not required steps identifying at least a sub-set of mechanical components in the mechanical schematics that are not supported by the electrical components in the electrical schematics of group III. See MPEP § 806.05(d).

4. Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as invention of group III does not required steps examining the existing schematic to identify sections of the existing schematic that are inconsistent with the best design practices specified in the template set of group V and invention of group V does not required steps identifying at least a sub-set of mechanical components in the mechanical schematics that are not supported by the electrical components in the electrical schematics of group III. See MPEP § 806.05(d).

5. Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as invention of group IV does not required steps examining the existing schematic to identify sections of the existing schematic that are inconsistent with the best design practices specified in the template set of group V and invention of group V does not required steps monitoring for changes to the mechanical schematic; for each change to the mechanical

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schematic, storing an indication of the change in a database of group IV. See MPEP § 806.05(d).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. A telephone call was made to Attorney Michael A. Jaskolski on 04/23/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John H Le whose telephone number is 571-272-2275. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John H. Le

Patent Examiner-Group 2863

April 26, 2004



John Zariow
Supervisory Patent Examiner
Technology Center 2800